III.   REMARKS

Claims 1-29 are pending in this application. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 5, 14, 18 and 25 are objected to as being dependent upon rejected base claims, but would be allowable if rewritten in independent forms including all of the limitations of the base claims and any intervening claims. Applicant gratefully appreciates this indication, although Applicant respectfully submits that such rewritings are not necessary because claims 5, 14, 18 and 25 are allowable for their allowable base claims, as well as for their own additional features, as discussed below.

In the Office Action, claims 1-4, 8, 10-13, 15-17, 19-20, 23-24 and 26-27 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Smith, Jr. (U.S. Patent No. 5,754,755), hereafter "Smith"; claims 6-7, 9, 21-22 and 28-29 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Smith. Applicant respectfully traverses these rejections for the reasons stated below.

A.   REJECTION OF CLAIMS 1-4, 8, 10-13, 15-17, 19-20, 23-24 and 26-27 UNDER 35 U.S.C. §102(b)

With regard to the 35 U.S.C. §102(b) rejection over Smith, Applicant asserts that Smith does not teach each and every feature of the claimed invention. For example, with respect to independent claims 1, 10, 16-17 and 23-24, Applicant submits that Smith fails to teach "providing a table having test data for the software product, the table being a column-row matrix of test data[.]" (Claim 1). Instead, the output file generator in Smith "...receives an ordered list of customizing files that have application-specific placeholder values." (Col. 2, lines 32-34). Please note that Smith discloses an ordered list of customizing files, not a table of a column-row matrix of test data as in the claimed invention. As is well known in the art, a file is not equivalent to a test datum. Moreover, the customizing files of Smith are specified as being in an ordered list and not a table. Furthermore, the ordered list of files in Smith is only specified as having application-specific placeholder values and not as being a column-row matrix of "test data." In sum, nowhere does Smith teach that its ordered list of customizing files is a table or that the table is a column-row matrix of test data. In contrast, the claimed invention includes "...providing a table having test data for the software product, the table being a column-row matrix of test data." (Claim 1). In view of the foregoing, the ordered list of customizing files in Smith is not equivalent to the table of test data as included in the claimed invention. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

In the Office Action, however, the Office asserts that "an ordered list is inherently a table that is a column-row matrix since it is possible to have a table that is 1 x n or n x 1 where n can be any positive integer." (Office Action at page 2). (Emphasis added). Applicant respectfully

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traverses this assertion because "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (MPEP §2112 IV). (Emphasis in original). Rather, "[in] relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristic necessarily flows from the teachings of the applied prior art." (*Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat App. & Inter. 1990). (Emphasis in original). In this case, Smith does not necessarily include a table of a column-row matrix of test data because the customizing files in Smith are to be searched by the output file generator according to the ordered list for a first placeholder value for the placeholder of the test instruction. (See col. 2, lines 33-38.) That is, first value for first placeholder in Smith. Because of this specific searching mechanism in Smith, the customizing files of Smith are not necessarily (actually not expected to be) organized as a matrix other than as an ordered list. Based on the disclosure of Smith, the customizing files in Smith are better organized as an ordered list to be searched than as a matrix. In view of the foregoing, the Office does not establish an inherent table in Smith.

With respect to the Office's other arguments regarding dependent claims, Applicant herein incorporates the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicant submits that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicant respectfully requests withdrawal of this rejection.

B.   REJECTION OF CLAIMS 6-7, 9, 21-22 and 28-29 UNDER 35 U.S.C. §103(a)

With regard to the 35 U.S.C. §103(a) rejection over Smith, Applicant asserts that Smith fails to teach or suggest each and every feature of the claimed invention. For example, with respect to claims 6 and 21, Applicant respectfully submits that Smith fails to teach or suggest "...the test script file is an executable file that is automatically run by an automation tool." The Office admits that Smith does not explicitly disclose automatically running the test script with an automation tool. Instead, the Office states that, based on the background on Smith, it would have been obvious to one of ordinary skill at the time of the invention to include the automatic testing due to the importance of thorough testing. However, Smith teaches away from an executable file, in that the test script generated by Smith, instead of automatically running with an automation tool, appears to be written in a macro language that is capable of running independently of an automation tool. (Col. 2, lines 8-22; FIG. 2). For the above stated reasons, Applicant asserts that Smith does not teach an executable file. Accordingly, Applicant respectfully requests that the Office withdraw the rejection.

With respect to claims 7 and 22, Applicant respectfully submits that Smith fails to teach or suggest "...the test script file is a documentation file that is manually run by a user." The Office admits that Smith does not explicitly disclose automatically running the test script manually by a user. Instead, the Office takes Official Notice that in the art of software testing it is well known to use a stepping procedure performed manually by a user to step through a program in order to debug a program. However, this factual assertion is unsubstantiated and is not properly based upon common knowledge. Furthermore, the test script generated by Smith, instead of being a documentation file that is manually run by a user, appears to be written in a

macro language that is capable of running independently of a user. (FIG. 2). For the above stated reasons, Applicant asserts that a test script file that is a documentation file that is manually run by a user is not obvious to one skilled in the art as asserted by the Office. Accordingly, Applicant respectfully requests that the Office withdraw the rejection or support the finding with references that show these features.
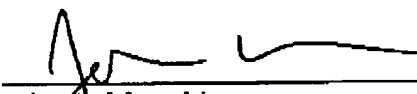
With regard to the Office's other arguments regarding dependent claims, Applicant herein incorporates the arguments presented above with respect to independent claims listed above. In addition, Applicant submits that all dependant claims are allowable based on their own distinct features. However, for brevity, Applicant will forego addressing each of these rejections individually, but reserves the right to do so should it become necessary. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

IV.   CONCLUSION

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

Date: 9/21/05

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